

Please enter the following amendments and remarks:

STATUS OF THE CLAIMS

Claims 1-16 are pending in the Application.

Claims 1-16 have been rejected by the Examiner.

Claims 1, 7 and 14 have been amended herein.

Reconsideration of the present Application is respectfully requested.

REMARKS

Claims 1-16 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Ludwig (U.S. Patent No. 6,256,498) and further in view of Laursen (U.S. Patent No. 6,233,608).

35 U.S.C. §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *MPEP 706.02(j)*.

A. Independent Claims 1 and 14

Claims 1 and 14 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Ludwig (U.S. Patent No. 6,256,498) and further in view of Laursen (U.S. Patent No. 6,233,608). Applicant respectfully traverses these rejections for at least the following reasons.

Examiner rejects Claim 1, setting forth portions of Ludwig and Laursen, respectively, stating:

In addition, the mobile station establishes a connection to a mobile device roaming together with the mobile station to receive a request for the location specific data from the mobile device and to transfer the location specific data to the mobile device. Ludwig Co. 3, lines 42-46.

And

Each mobile phone is assigned to device ID which can be a phone number of the phone or combination of an IP address and a port number for example: 204.163.65.132.01905 where 204.163.165.132 is the IP address and 09105 is the port number. Laursen Col. 7, lines 57-61.

Amended Claim 1 recites,

A method for sending local information from a wireless handset to a Web server utilizing the phone dialing process comprising the following steps:

- (a) receiving a service request from a user of the wireless handset via a wireless data transmission passing through at least one wireless base station, wherein the service request comprises a type of local information needed to carry out the service request;
- (b) acquiring the local information; and,
- (c) sending the local information to the Web server via a uniform resource locator,

wherein the phone dialing process is modified to send the local information as part of the uniform resource locator.

Applicant respectfully submits that Ludwig fails to teach "receiving a service request from a user of the wireless handset via a wireless data transmission passing through at least one wireless base station" as recited in Amended Claim

1. The present Office Action sets forth that "one ordinary skill in the art at the time of the invention knows that server is define as a processor that process the service request and Laursen disclosed above that in terms of functionality is same as the

cellular phone or wireless handset.” Amended Claim 1 recites “via a wireless data transmission passing through at least one wireless base station.” Support for this amendment may be found in Figure 1 and the discussion associated therewith.

Applicant respectfully submits that a processor that processes the service request having functionality the same as a cellular phone does not teach each of the elements of Amended Claim 1, at least because the use of a server in substitution for a wireless handset would not require the use of a wireless base station.

Because the combination of Ludwig and Laursen does not teach the use of a wireless handset transmitting via a wireless base station, Applicant submits this rejection has been overcome.

Further, Applicant submits that Ludwig fails to teach “receiving a service request from a user of the wireless handset, wherein the service request comprises a type of local information needed to carry out the service request.” Instead, Ludwig teaches “[f]urther, a mobile station MS usually receives the location specific information not only from the base station subsystem BBS 1 wherein it is roaming, but also from adjacent base station sub-systems BSS 2 to BSS S.” The present office action recites a portion of Ludwig, as identified hereinabove, that states “[i]n addition, the mobile station establishes a connection to a mobile device roaming together with the mobile station to receive a request for the location specific data from the mobile device and to transfer the location specific data to the mobile device.”

Claim 1 recites sending the local information to the Web server via a uniform resource locator by modifying the phone dialing process while the cited art teaches establishing a connection to receive a request for the location data. Applicant respectfully submits that “wherein the phone dialing process is modified to send the local information as part of the uniform resource locator,” is not disclosed in the prior art. Applicant submits, as noted in the above citation, that Ludwig fails to teach modifying the phone dialing process to send local information as part of the uniform resource locator. Applicant further respectfully submits that Laursen fails to remedy this shortcoming in the teaching of Ludwig.

The present office action does allude to Laursen and the use of the device ID including a portion of the phone number. Applicant respectfully submits that modifying the phone dialing process to send local information as part of the uniform resource locator is clearly not merely obvious over the use of a device ID including a phone number.

Applicant respectfully traverses the 35 U.S.C. § 103 rejection with respect to Claim 1 for at least the foregoing reasons. Similarly, Applicant respectfully submits that Claim 1 is patentably distinguishable over the prior art of record. Analogously, Applicant respectfully submits that Claim 2 – 6 similarly overcome the prior art, at least because of these Claims’ ultimate dependence on patentably distinguishable base Claim 1.

With respect to Claim 14, the present Office Action sets forth the rejection discussed hereinabove with respect to Claim 1. Applicant respectfully submits that

Claim 14 is similarly not obvious over the prior art cited for at least the reasons set forth with respect to Claim 1.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on an applicant's disclosure. *In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)*. More specifically, MPEP2144.08 (II)(A) states:

To establish a *prima facie* case of obviousness in a genus-species chemical composition situation, as in any other 35 U.S.C. 103 case, it is essential that Office personnel find some motivation or suggestion to make the claimed invention in light of the prior art teachings. See, e.g., *In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991)* ("[A] proper analysis under 103 requires, *inter alia*, consideration of . . . whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process."). In order to find such motivation or suggestion there should be a reasonable likelihood that the claimed invention would have the properties disclosed by the prior art teachings. . . . See, e.g., *Vaeck, 947 F.2d at 493, 20 USPQ2d at 1442* (A proper obviousness analysis requires consideration of "whether the prior art would also have revealed that in so making or carrying out [the claimed invention], those of ordinary skill would have a reasonable expectation of success.")

The Examiner has not met the burden of establishing a *prima facie* case of obviousness using the Laursen reference by failing to provide express support from the art cited against Applicant. Rather, the Examiner has merely stated that

some suggestion or motivation exists or would be within the “skilled level of the artisan . . . absent evidence to the contrary.” Id. MPEP 2144.08 states:

Based on the evidence as a whole (In re Bell, 991 F.2d 781,784, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); In re Kulling, 897 F.2d 1147, 1149, 14 USPQ2d 1056, 1057 (Fed. Cir. 1990)), Office personnel should make express fact-findings relating to the Graham factors, focusing primarily on the prior art teachings [as captured by the Graham factors]. **The fact-findings should specifically articulate what teachings or suggestions in the prior art would have motivated one of ordinary skill in the art to select the claimed species or subgenus.** Kulling, 897 F.2d at 1149, 14 USPQ2d at 1058; Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1579 n.42, 1 USQP2d 1593, 1606 n.42 (Fed. Cir. 1987). Thereafter, it should be determined whether these findings, considered as a whole, support a prima facie case that the claimed invention would have been obvious to one of ordinary skill in the relevant art at the time the invention was made. [emphasis added]

Specifically, the present Office Action sets forth that “it would have been obvious to one having ordinary skill in the art at the time the invention was made . . .” Applicant respectfully submits that this statement does not meet the burden of establishing fact-findings specifically articulating what teachings or suggestions in the prior art would have motivated one of ordinary skill in the art to combine the teaching of Laursen with that of Ludwig. In response, the present Office Action represents that the use of “Laursen in the method of Ludwig to make the system more efficient in terms of communication with data network through wireless means”. Applicant respectfully submits that this does not reach the burden required to combine references. The efficiency that the present Office

Action suggests as the motivation to combine the references strongly supports the patentability of the present application, at least in that the desire for improved efficiency, expressed in the prior art is a long felt need met by the present invention. Further, efficiency alone does not meet the burden for combining references.

Applicant further respectfully traverses the 35 U.S.C. § 103 rejection with respect to Claim 14 for at least the foregoing reasons. Similarly, Applicant respectfully submits that Claim 14 is patentably distinguishable over the prior art of record. Analogously, Applicant respectfully submits that Claim 15 – 16 similarly overcome the prior art, at least because of these Claims' ultimate dependence on patentably distinguishable base Claim 14.

Wherefore, Applicant respectfully requests reconsideration and removal of these 35 U.S.C. 103(a) rejections to Claims 1 – 6 and 14 – 16, for at least the foregoing reasons.

B. Independent Claim 7

Claim 7 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Ludwig (U.S. Patent No. 6,256,498) and further in view of Laursen (U.S. Patent No. 6,233,608). Applicant respectfully traverses these rejections for at least the following reasons.

Applicant respectfully submits that Ludwig in view of Laursen fails to render Claim 7 unpatentable.

Claim 7 recites:

A method for using a wireless browser to send local information from a wireless handset to a Web server or to dial a telephone number comprising the following steps:

receiving an input from a user of the wireless handset via a wireless data transmission passing through at least one wireless base station, wherein the input comprises either a service request containing a type of local information needed to carry out the service request, or a telephone number to be dialed;

determining whether the input comprises a service request or a telephone number;

if the input is a telephone number, terminating the browser and dialing the telephone number; and

if the input is a service request, acquiring the local information and sending the local information to the Web server via a uniform resource locator,

wherein the phone dialing process is modified to send the local information as part of the uniform resource locator.

Applicant respectfully submits that Claim 7 is similarly not obvious over the prior art cited for at least the reasons set forth with respect to Claim 1 and 14.

Further, Applicant respectfully asserts that the present Office Action has failed to set forth the factual findings necessary to meet the burden of articulating that teachings or suggestions in the prior art would have motivated one of ordinary skill in the pertinent art to combine the teachings of Ludwig and Laursen.

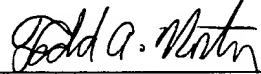
Applicant respectfully traverses the 35 U.S.C. § 103 rejection with respect to Claim 7 for at least the foregoing reasons. Similarly, Applicant respectfully submits that Claim 7 is patentably distinguishable over the prior art of record. Analogously, Applicant respectfully submits that Claim 8 – 13 are similarly free of the prior art, at least because of these Claims’ ultimate dependence on patentably distinguishable base Claim 7.

Wherefore, Applicant respectfully requests reconsideration and removal of these rejections, as Claims 1, 7 and 14 are patentably distinguishable over the prior art of record. Applicant further submits each of Claims 2 – 6, 8 – 13 and 15 – 16 is similarly distinguishable over the prior art of record, at least by virtue of these Claims’ ultimate dependency from a patentably distinct base Claim 1, 7, or 14.

Conclusion

Applicant respectfully requests reconsideration of the present Application in light of the reasons set forth herein, and a Notice of Allowance for all pending claims is earnestly solicited.

Respectfully Submitted,



TODD A. NORTON
Registration No. 48, 636
THOMAS J. MCWILLIAMS
Registration No. 44,930
2500 One Liberty Place
1650 Market Street
Philadelphia, PA 19103
(215) 851-8100
Attorneys for Applicant